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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/455,805

12/07/1999

SUSAN D. WOOLF

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05/23/2006

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/455,805	Applicant(s) WOOLF ET AL.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 03/30/2006 to the original application filed 12/07/1999.
2. Claims 1-29 are currently pending in this application. Claims 1, 10, 16, and 29 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/30/2006 has been entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5-10, 13-16, and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** (U.S. 5,680,636 - issued 10/1997) in view of **Cassorla et al.** (U.S. 5,146,552 – issued 02/1992, as cited in the Applicant's IDS filed 10/24/2002).

As to claim 16:

Levine teaches a computer-readable storage medium comprising computer-executable instruction for performing steps (*e.g., see fig.1 a and the accompanying text, beginning at col.9, line 13*) comprising:

- displaying an electronic document page on a computer display device permitting a user to move forward and backward among a plurality of document pages (*e.g., the display screen and/or have several pages ... scrolling from top to bottom of a single page or sequentially from one page to succeeding or preceding pages; col.20, lines 44-48*); and
- annotating parts of a currently displayed page in accordance with movement of a user input device to indicate where on the currently displayed document page the annotations should appear (*e.g., the user simply places one end of the stylus on the table position which corresponds to the position of the typing cursor in the*

displayed view of the document being annotated and move the stylus end across the surface of the tablet to the desired position; col.4, lines 18-39).

Levine, however, does not specifically teach “*storing annotations separate from the electronic document.*”

Cassorla teaches storing annotations separate from the electronic document (*e.g., the record of such annotations or "place marks" can be stored within or separately from the published material. Annotations stored separately from the originally published document are associated by name with the document and can either be accessed by a particular individual reader and/or shared and exchanged between individuals with access to the same 'or copies of the' published electronic document for a variety of purposes; col.2, lines 16-55).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Cassorla in the system of Levine because it would have permitted a reader of an electronically published document to create notes, bookmarks or annotations and relate them to a particular location in the document (Cassorla; Abstract).

As to claim 19:

Levine teaches instructions for erasing portions of previously created annotations (*col.6, lines 1-10*).

As to claim 20:

Levine teaches in response to detecting that the user has moved to a different document page (*col.19, lines 23-38*), retrieving previously stored annotations associated with the different document page; and displaying the annotations retrieved in step (a) on the different document page (*col.20, lines 18-57*).

As to claim 21:

Levine teaches annotations are stored in a data structure as strokes (*e.g., strokes of the stylus; col.2, lines 33-36 & col.6, lines 29-56*).

As to claim 22:

Levine teaches each stroke includes a stroke width and coordinates indicating a trajectory of the stroke (*col.6, lines 30-50*).

As to claims 23 & 28:

Levine teaches annotations are stored as a bitmap image (*e.g., An annotatable bit map image; see Abstract*).

As to claim 27:

Levine teaches annotations are stored in a data structure as strokes (*col.6, lines 29-38*).

As to claim 10:

Note the rejection of claim 16 above. Claim 10 includes the same limitations as in claim 16, except claim 16 is a computer-readable storage medium claim and claim 10 is a method claim.

As to claim 13:

Levine teaches the computer software displays and stores erased annotations that remove previously made annotations on the currently displayed document page (*e.g., the area on the document which has presently been erased by the stylus is restored; col.5, lines 51-55*).

As to claim 14:

Levine teaches a flat panel display, and wherein the computer input device comprises a stylus (*col.6, lines 30-50*).

As to claim 15:

Levine teaches upon detecting a title change event, previously stored annotations associated with a different document page (*col.19, lines 58-col.20, line 11*) and displays the previously stored annotations on the different document page (*col.20, lines 18-57*).

As to claim 24:

Levine teaches annotation mode selection menu (*col.5, lines 8-45*).

As to claims 25-26:

Note to the discussion of claims 27-28, respectively, for rejections.

As to claim 1:

The rejection of independent claim 16 above is fully incorporated herein.

Additionally, Levine teaches selecting an annotation mode that permits the user to annotate the currently displayed document page (*e.g., annotated by the user selecting a “note pad” option displayed in the desk view; col.4, lines 4-17*).

As to claim 5:

Levine teaches instructions for erasing portions of previously created annotations (*col.6, lines 1-10*).

As to claim 6:

Levine teaches the step of using a stylus with a tablet computer system (*e.g., the electronic stylus and tablet; col.1, lines 52-60*).

As to claim 7:

Levine teaches the step of storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated (*col.6, lines 51-56*).

As to claim 8:

Levine teaches moving to a different document page (*col.20, lines 44-57*); retrieving previously stored annotations associated with the different document page; and displaying the retrieved annotations on the computer display device superimposed over the different document page (*see the Abstract*).

As to claim 9:

Levine teaches the step of detecting a title change event in the document browser and, in response thereto, locating an annotation file corresponding to the different document page (*col.19, line 58-col.20, line 11*).

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5. Claims 2-4, 11-12, 17-18, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** in view of **Cassorla** as applied to claims 1, 10 and 16 above, and further in view of **Alexander** (U.S. 6,320,577 –filed 11/1998).

As to claim 2:

The combination of Levine and Cassorla does not specifically teach “*using opaque markings that obscure portions of the currently displayed document page.*”

Alexander teaches using opaque markings that obscure portions of the currently displayed document page (*col.23, lines 5-12*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander’s teachings in the system of Levine as modified by Cassorla because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

As to claim 3:

The combination of Levine and Cassorla does not specifically teach “*using a translucent highlighting that does not completely obscure the annotated portions of the currently displayed document page.*”

Alexander teaches using a translucent highlighting that does not completely obscure the annotated portions of the currently displayed document page (*col.23, lines 5-12*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander's teachings in the system of Levine as modified by Cassorla because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

As to claim 4:

The combination of Levine and Cassorla does not specifically teach "*blending pixels from the currently displayed document with a translucent color to produce a translucent annotation.*"

Alexander teaches blending pixels from the currently displayed document with a translucent color to produce a translucent annotation (*col.23, lines 13-28*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander's teachings in the system of Levine as modified by Cassorla because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

As to claims 11&12:

Note to the discussion of claims 2 & 3, respectively, for rejections.

As to claims 17&18:

Note to the discussion of claim 2 & 3-4 for rejection.

As to claim 29:

The rejection of independent claim 16 above is fully incorporated herein. Additionally,

Levine teaches:

- determining an initial position of the annotation (*col.4, lines 18-39*);
- determining a width and trajectory of the annotation (*col.6, lines 30-5*); and
- receiving a signal representing that the annotation is complete (*col.6, lines 19-28*).

Levine teach displaying the annotation that is superimposed over on the document page (*e.g., annotations are superimposed on displayed, annotatable image; Abstract*).

However, *the combination of Levine and Cassorla does not specifically teach “displaying the annotation in an ink layer that is blended with pixels on the document page.”*

Alexander teaches displaying the annotation in an ink layer that is blended with pixels on the document page (*col.22, line 60-col.23, line 13*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander's teachings in the system of Levine as modified by Cassorla because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

Response to Arguments

6. Applicants' arguments filed 03/30/2006 have been fully considered but are moot in view of the new ground(s) rejection.
7. The newly submitted declaration under 37 CFR 1.131 is sufficient to overcome the Eintracht reference (U.S. 6,678,878, filed 03/15/1999).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - Ho U.S. Patent No. 6,064,384 Issued: May 16, 2000
 - Ho U.S. Patent No. 6,340,980 Issued: Jan. 22, 2002
 - Landay et al., "Making Sharing Pervasive: Ubiquitous Computing for Shared Note Taking," IBM Systems Journal, Vol. 38, No. 4, 1999, pp. 531-550.

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- Landay, J. A., "Using Note-Taking Appliances for Student to Student Collaboration," 29th Annual Frontiers in Education Conference, IEEE Computer Society, November 1999, p. Session 12C4/15-12C4/20.

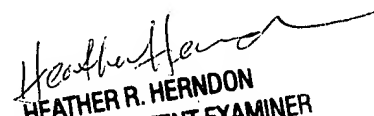
Contact information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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